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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,285	06/01/2006	Tetsuro Iwanaga	1422-0718PUS1	3178

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EXAMINER

KARPINSKI, LUKE E

ART UNIT	PAPER NUMBER
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1616

NOTIFICATION DATE	DELIVERY MODE
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09/28/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/581,285	Applicant(s) IWANAGA ET AL.	
	Examiner LUKE E. KARPINSKI	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/01/2006, 9/14/2006, 6/05/2008, 8/26/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims

Claims 1-5 are currently pending and under consideration in this action.

Priority

It is acknowledged that applicant claims priority to JP 2003-405875 filed 12/04/2003, however, applicant has not submitted an English translation of said document to perfect priority.

Rejections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.

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3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,466,719 to Jakobson et al.

Applicant Claims

Applicant claims compositions comprising a fatty acid ester and a non-ionic surfactant wherein said ester is formed from a fatty acid having 6-10 carbon atoms and a polyglycerol having an average degree of polymerization of 3-100.

Applicant also claims an oil, 0-80% water and said composition as a cleansing cosmetic.

Determination of the Scope and Content of the Prior Art

(MPEP §2141.01)

Jakobson et al. teach cleansing compositions (col. 10, lines 44-50) comprising polyglycerol fatty acid esters made through the reaction of polyglycerols having a degree of polymerization of 2-8 and fatty acids having 6-14 carbon atoms (abstract) as pertaining to claim 1.

Jacobson et al. further teach liquid oil components (col. 6, lines 21-46) as pertaining to claim 2, 0-70% water (col. 5, line 13), as pertaining to claim 3, and said compositions as cleansing bathing cosmetics (col. 10, lines 44-51), as pertaining to claims 4 and 5.

Ascertainment of the differences between the prior art and the claims

(MPEP 2141.01)

Jakobson et al. do not explicitly disclose an example wherein the claimed components, at the claimed percentages are combined into a single composition. However, Jakobson et al. do teach that all of said components may be included in a cleansing cosmetic.

Finding of prima facie Obviousness Rational and Motivation

(MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select each component and combine them as instantly claimed because Jakobson et al. suggest that the instant components can be combined

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or mixed together. In a prior art reference it is not necessary for all of the possible compositions to be exemplified in order for the art to render an invention obvious.

Regarding the limitation of a non-ionic surfactant, said compositions may comprise of a mixture of said fatty acid esters, which reads on a non-ionic surfactant.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-2003-012456 utilizing the enclosed translation, hereafter referred to as JP-456.

Applicant Claims

Applicant claims are delineated above and incorporated herein.

Determination of the Scope and Content of the Prior Art

(MPEP §2141.01)

JP-456 teaches cleansing creams [1] comprising polyglycerol fatty acid esters [4], comprising polyglycerin with a degree of polymerization of three or more and fatty acids having 8-22 carbon atoms [6], as pertaining to claim 1.

JP-456 further teaches oils, such as liquid paraffin [12], as pertaining to claim 2, and said compositions as cleansing creams [1], as pertaining to claims 4 and 5.

Ascertainment of the differences between the prior art and the claims
(MPEP 2141.01)

JP-456 does not explicitly disclose an example wherein the claimed components, at the claimed percentages are combined into a single composition. However, JP-456 does teach that all of the claimed components may be combined into the same composition.

Finding of prima facie Obviousness Rational and Motivation
(MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select each component and combine them as instantly claimed because JP-456 suggests that the instant components can be combined or mixed together. In a prior art reference it is not necessary for all of the possible compositions to be exemplified in order for the art to render an invention obvious.

Regarding claim 3, JP-456 does not mention any water percentage which reads on 0%.

Regarding the limitation of a non-ionic surfactant, said fatty acid esters are utilized as non-ionic surfactants and it is common in the art to utilize more than one of any type of surfactant, which reads on a non-ionic surfactant.

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From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-2001-025654 utilizing the enclosed translation, herein referred to as JP-285.

Applicant Claims

Applicant claims are delineated above and incorporated herein.

Determination of the Scope and Content of the Prior Art

(MPEP §2141.01)

JP-285 teaches compositions comprising polyglycerol fatty acid esters [1], comprising fatty acids with 8-24 carbons [8] and a degree of polymerization of 4-12 [11] as pertaining to claim 1.

JP-285 further teaches oil components [2] and [7], as pertaining to claim 2, and cleansing shampoos [16], as pertaining to claims 4 and 5.

Ascertainment of the differences between the prior art and the claims

(MPEP 2141.01)

JP-285 does not explicitly disclose an example wherein the claimed components, at the claimed percentages are combined into a single composition. However, JP-285 does teach that each of the claimed components may be combined into the same cleansing composition.

Finding of prima facie Obviousness Rational and Motivation
(MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select each component and combine them as instantly claimed because JP-285 suggests that the instant components can be combined or mixed together. In a prior art reference it is not necessary for all of the possible compositions to be exemplified in order for the art to render an invention obvious.

Regarding claim 3, JP-285 does not mention any water percentage which reads on 0%.

Regarding the limitation of a non-ionic surfactant, said fatty acid esters are utilized as non-ionic surfactants and it is common in the art to utilize more than one of any type of surfactant, which reads on a non-ionic surfactant.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-08099852, utilizing the enclosed translation, herein referred to as JP-852.

Applicant Claims

Applicant claims are delineated above and incorporated herein.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

JP-852 teaches compositions comprising medium chain fatty acid esters [4], comprising acids with 8-14 carbon atoms and a degree of polymerization of 4 [5] (tetraglycerol), as pertaining to claim 1.

JP-852 further teaches oils [6], as pertaining to claim 2, 10-80% water [7], as pertaining to claim 3, and that said compositions may be a liquid detergent [7], as pertaining to claims 4 and 5.

***Ascertainment of the differences between the prior art and the claims
(MPEP 2141.01)***

JP-852 does not explicitly disclose an example wherein the claimed components, at the claimed percentages are combined into a single composition. However, JP-852 does teach that each of the claimed components may be combined into the same cleansing composition.

Finding of prima facie Obviousness Rational and Motivation

(MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select each component and combine them as instantly claimed because JP-852 suggests that the instant components can be combined or mixed together. In a prior art reference it is not necessary for all of the possible compositions to be exemplified in order for the art to render an invention obvious.

Regarding the limitation of a non-ionic surfactant, said fatty acid esters are utilized as non-ionic surfactants and it is common in the art to utilize more than one of any type of surfactant, which reads on a non-ionic surfactant.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

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Conclusion

Claims 1-5 are rejected.

No claims are allowed.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE E. KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on Monday Friday 9-5 est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

/Mina Haghighatian/
Primary Examiner, Art Unit 1616